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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,745	03/29/2001	Satoru Bushida	010381	2670

23850 7590 11/18/2003

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 WASHINGTON, DC 20006

EXAMINER

MENEFE, JAMES A

ART UNIT	PAPER NUMBER
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2828

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,745

Applicant(s)

BUSHIDA ET AL.

Examiner

James A. Menefee

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 06 October 2003.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 9-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 9-12 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Paul IP

PAUL IP

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/5/2003 has been entered. Claims 1-8 are cancelled and 9-12 added. Claims 9-12 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Algots et al. (US 6,192,064, previously cited).

Regarding claim 9, Algots discloses a wavelength control device for a laser device comprising a movable holder including a piezoelectric element 14B and a pulse motor unit 15, capable of moving an optical component 14C with respect to the laser optical axis to change an incident angle of laser light on a band narrowing optical component (the grating). There is a laser

controller 24A controlling driving of the piezoelectric element 14B to move the optical component 14C to set a center wavelength of the laser light at a target wavelength, and controlling driving of the piezoelectric element 14B or the pulse motor unit 15 to maintain the center wavelength at the target wavelength.

Algots does not disclose any particular order in which the driving of the elements is done, and therefore does not disclose “subsequent driving” as claimed. However, this limitation is deemed to be a manner of operating the device that is describing what the device does, and therefore is not given weight to distinguish over the prior art. See the response to arguments section below.

Regarding claims 10-12, the structural limitations are taught as in the rejection of claim 9. There are additional functional recitations concerning the manner of operating the device that detail what the device does. These are similarly not given weight to distinguish from the prior art.

Response to Arguments

Applicant's arguments filed 9/5/2003 have been fully considered but they are not persuasive.

Applicant's entire arguments are based on the assertion that Algots and the present claims do not operate in the same manner. Particularly, certain functional steps are recited in the claims detailing the operation of the claimed invention differently than the operation shown in Algots. These arguments are not persuasive.

Applicant argues, “a functional statement...must be evaluated and considered, just like any other limitation in the claim.” Applicant cites MPEP 2173.05(g) as support. However, section 2173 of the MPEP is concerned with indefiniteness of the claims under 35 U.S.C. 112. MPEP 2173.05(g) further states “Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph is a different issue from whether the limitation...is distinguished over the prior art.” Thus, section 2173 of the MPEP appears to be concerned only with whether the functional statements cause the claim to be indefinite. It attempts to distinguish itself from the issue of patentability over the prior art. The Examiner makes no contention that the claims are indefinite because of the functional statements, and thus section 2173 is not further applicable here. Since the claims are deemed to be definite, then the question is what weight the Examiner should give the functional limitations. This will be discussed below.

Apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation); *see also In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) (where the functional limitation does not further define structure, the limitation may not serve to distinguish). Here, all of the structural limitations are found in the prior art; the functional statements may not serve to distinguish.

The courts have further decided that “apparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Here, the claims are apparatus claims, and thus cover what the device is, i.e. the structural limitations, not what the device does, i.e. the operation of the device. Again, all of the structural limitations are met as in the rejection above.

The manner of operating a device does not differentiate the apparatus claim from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (when all of the structural limitations of the claim are met, and the functional recitation does not impose any structural limitations upon the claimed apparatus to distinguish over the prior art, then the claim is anticipated by the prior art); *see also In re Dilnot*, 300 F.2d 945, 949 (CCPA 1962) (The addition of a method step in a product claim, which product is not patentably distinguishable from the prior art, cannot impart patentability to the old product). Again, here all of the structural limitations are disclosed in the prior art. The manner of operation cannot serve to distinguish.

In order for the functional statements concerning the operation of the device to be considered as distinguishing from the prior art, applicant must claim a method claim, or must put the functional limitation in means-plus-function form under 35 U.S.C. 112 6th paragraph. The claims were previously in means-plus-function format, but the amendments have removed such limitations, therefore they need not be addressed here.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JM
November 7, 2003



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